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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/314,034 05/18/99 SCHULZ

M 54565USA4A

EXAMINER

IM22/0510

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ART UNIT

PAPER NUMBER

1774

DATE MAILED:

05/10/01

*7*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/314,034

Applicant(s)

Schulz et al.

Examiner

Grendzynski, Michael E.

Art Unit

1774

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 18, 1999
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) 12-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election with traverse of Group I(a) (claims 1-11) in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the inventions are so interrelated that a search of one group of claims will reveal art to the other. This is not found persuasive because, as indicated in the March, 2001 Office Action (Paper No. 5), these inventions are distinct and the search required for Group I is not required for Groups II or III (and the search for group II is not required for groups I or III). Additionally, the distinctness of these inventions is further evidenced by the fact that they have each acquired a separate status in the art as shown by their different classification. Consequently, the requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 U.S.C. § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-3, 5-6, and 8 rejected under 35 U.S.C. 102(b) as being anticipated by Bussell (US 5192363).

Applicants claim an ink-receiving medium comprising (1) a porous substrate and (2) a fluid management system comprising a surfactant, along with a pigment management system comprising a metal salt (e.g.,

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aluminum sulfate), thereon. Bussell discloses a paper sizing composition comprising a surfactant (e.g., sulphosuccinate salts, *see* col. 4, l 38 through col. 6, l 18) and an aluminum salt, such as polyaluminum chloride or aluminum sulfate (*see* col. 3, l 45 through col. 4, line 10 and col. 1, ll 57-61). The composition is placed in or on paper. *See* col. 7, ll 41-42. Paper, inherently, is porous.

4. Claims 1-3, 7, and 8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Imashiro (US 6177197). *See* col. 6, ll 50-58; col. 7, l 1 and ll 30-45. Paper is inherently porous. Once the ink-receiving layer is coated onto the paper, it is inherent the layer is in contact with the paper.

5. Claims 1, 2, 7, 8, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kobayshi. *See* col. 4, ll 36-68.

***Claim Rejections - 35 U.S.C. § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Bussell (US 5192363) or Imashiro (US 6177197), in view of applicants statement of the prior art.

With specific regard to claim 4, The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicant's claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. Porosity is a conventional concern in the art, for it controls the absorption of pigment into an ink-receiving medium. Consequently, it would be obvious to optimize.


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With specific regard to claims 6 and 9-11, the claimed genera of surfactants all appear to be well known in the art. Their use in an ink-receiving medium would be expedient to one of ordinary skill in the art.

8. Should you have any questions concerning this communication, please direct them to Michael E. Grendzynski at telephone number (703) 305-0593. The examiner can be reached at this number from 7:00 a.m. to 3:30 p.m. Monday-Friday. If attempts to reach the examiner by telephone prove unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached at (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1774 are (703) 305-3599 for official after final faxes, and (703)305-5408 for all other official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-2351.



Michael E. Grendzynski  
Assistant Examiner  
May 4, 2001

**BRUCE H. HESS**  
**PRIMARY EXAMINER**